

Appln. No. 09/648,132  
Amendment dated November 18, 2003  
Reply to Office Action mailed August 29, 2003

**REMARKS**

Reconsideration is respectfully requested.

Claims 1-15 remain in this application.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

**Paragraph 1 of the Office Action**

Claims 1 and 12 have been objected to for the informalities noted in the Office Action.

Claims 1 and 12 have been amended in a manner believed to clarify any informalities in the language. Specifically, the typographical corrections noted in the office action have been incorporated.

Withdrawal of the objection to claims 1 and 12 is therefore respectfully requested.

**Paragraphs 2 and 3 of the Office Action**

Claims 1 and 12 have been rejected under 35 U.S.C. §102(b) as being anticipated by Breed (GB 2301922 A).

Claim 1, particularly as amended, requires the monitoring device to direct information to the reflective surface.

The Breed reference teaches monitoring system for inhibiting the deployment of an airbag system if an occupant is positioned in such a manner as to be injured by the deployment. See Abstract, page 2 lines 1 through 9, and page 13 line 11 through page 14 line 13 of Breed as illustrative examples. It is respectfully submitted that the disclosure of Breed does not provide each of the elements, as described by claims 1 and 12 of the present application, arranged as required by claims 1 and 12, and therefore claims 1 and 12, especially as amended, are allowable over the Breed reference.

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The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Withdrawal of the §102(b) rejection of claims 1 and 12 is therefore respectfully requested.

**Paragraphs 4-6 of the Office Action**

Claim 3 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Breed (GB 2301922 A) in view of Bauer (5,808,778). However, upon reading the rationale for the rejection provided in paragraph 6 of the office action, it is believed that the rejection is actually based upon Breed in view of Harris (4,687,305).

The Breed reference discloses an "optical identification and monitoring system using pattern recognition for use with vehicles." The nature of its disclosure is illustrated in part by the Summary Of The Invention section beginning of page 13 line 10 and continuing through page 16, line 8. As described throughout Breed, the system is an automated detection system for controlling another automated system of the vehicle. No meaningful feedback is provided to the user.

It is respectfully submitted that when the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F2d 810, 123 USPQ 349 (CCPA 1959)

It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of

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combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is further respectfully submitted that the combination of Breed with Harris is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Withdrawal of the §103(a) rejection of claim 3 is therefore respectfully requested.

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**Paragraph 7 of the Office Action**

Claims 4-11 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Breed (GB 2301922 A) and Harris Jr. (4,687,305) in view of Bauer (5,808,778).

As discussed above, no motivation for the combination of Breed with Harris is provided by either of these prior art references, and the addition of Bauer does nothing to overcome this deficiency. Further, Nothing in Breed, Harris, or Bauer, taken individually or in combination teaches, suggests or discloses the mounting of a monitoring mirror in a headrest.

The Bauer reference specifically, teaches a glare reducing system for rear-view mirrors. The section of this reference cited by the office action states:

"Automatic rearview mirror system embodying the present invention include an inside rearview mirror 11 which is shown in FIG.1 installed on the windshield 13 of a vehicle. The system 10 may also include outside electrochromic rearview mirrors 15 and 17 which may be installed on the outside of a vehicle in a conventional manner whereby each of the mirrors 11, 15, and 17 faces rearwardly of the vehicle in a conventional manner, it being understood that any desired combination of inside and/or outside mirrors may be utilized." Emphasis added.

Clearly, the reference not only fails to disclose the use of an mirror located on a headrest, but clearly teaches all of the mirrors facing rearwardly of the vehicle in a conventional manner.

Withdrawal of the §103(a) rejection of claims 4-11 is therefore respectfully requested.

**Paragraph 8 of the Office Action**

Claim 15 is allowed.

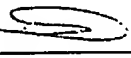
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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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